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EXAMINER
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MOHANDESI, JILA M

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JEFFREY E. GEBHARD

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Appeal 2009-002216  
Application 09/328,749  
Technology Center 3700

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Before LINDA E. HORNER, WILLIAM F. PATE III, and  
JENNIFER D. BAHR, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Jeffrey E. Gebhard (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 1-4, 7-21, and 23-26, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

## SUMMARY OF DECISION

We AFFIRM-IN-PART and, pursuant to our authority under 37 C.F.R. § 41.50(b), enter a NEW GROUND OF REJECTION for claims 1-4 and 7-20.

## THE INVENTION

Appellant's claimed invention is a torsion system for a cycling shoe. Spec. 1:5-6. Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A torsion system for a cycling shoe including a sole with a forefoot area and a rearfoot area, the torsion system including a longitudinal axis and comprising:

a forefoot portion of the torsion system spanning substantially the entire forefoot area of the sole from a midtarsal area to a toe area and from a lateral side to a medial side, the forefoot portion having a generally smooth concave contour along the longitudinal axis;

a rearfoot portion of the torsion system spanning substantially the entire rearfoot area of the sole from the midtarsal area to a heel area and from the lateral side to the medial side; and

an intermediate portion of the torsion system coupling the forefoot portion and the rearfoot portion, and constructed of

a material and configured to allow, in a pre-selected manner, rotation of the forefoot portion relative to the rearfoot portion about the longitudinal axis, wherein the intermediate portion includes a rib that projects beyond a bottom most surface of the torsion system.

#### THE EVIDENCE

The Examiner relies upon the following evidence:

Eisenbach	US 4,815,222	Mar. 28, 1989
Anderié	US 4,922,631	May 8, 1990
Nagano	US 5,446,977	Sep. 5, 1995

#### THE REJECTIONS

Appellant seeks review of the following rejections:

1. The Examiner rejected claims 1, 8-13, 15, 17, 20, 21, 24, and 26 under 35 U.S.C. § 102(b) as being anticipated by Anderié.
2. The Examiner rejected claims 23 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Anderié and Nagano.
3. The Examiner rejected claims 2-4, 11-14, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Anderié.
4. The Examiner rejected claims 2-4, 11-14, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Anderié and Eisenbach.
5. The Examiner rejected claims 16 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Anderié.

#### ISSUES

The issues presented by this appeal are:

Does Anderié disclose a rib that projects beyond a bottom most surface of the torsion system, as called for in claim 1?

Does the preamble recitation of “a cycling shoe”, as called for in claim 21, limit the claim or merely state an intended use of the claimed torsion system?

Is Anderié’s sports shoe capable of use as a cycling shoe?

Does Anderié disclose a rib that tunes torsionability of a cycling shoe, as called for in claim 26?

### ANALYSIS

*Procedural propriety of the Examiner’s rejection of claims 2-4, 7, 8, 10-14, 16-19, 21, and 23-25*

The Board issued a prior decision in the present application. *Ex Parte Gebhard*, Appeal No. 2005-2544 (BPAI Oct. 31, 2005) (“Prior Decision”). In the Prior Decision, the Board reversed the Examiner’s rejection of then-pending claims 1-4, 8-21, and 24-26 under 35 U.S.C. § 103(a) as being unpatentable over Anderié in view of Dubner and Kraeuter; claims 23 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Anderié in view of Dubner, Kraeuter, and Nagano; and claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Anderié in view of Dubner, Kraeuter, and Eisenbach. Prior Decision 8-9. The Board also entered a new ground of rejection of then-pending claims 1, 9, 15, 20, and 26 under 35 U.S.C. § 102(b) as being anticipated by Anderié. Prior Decision 9-11.

Subsequent to the Board’s Prior Decision, Appellant amended claims 1 and 26 in response to the Board’s new ground of rejection. Amendment and Response Under 37 C.F.R. 41.50(b)(1), dated December 23, 2005. The Examiner then issued an office action maintaining the Board’s rejection of

claims 1, 9, 15, 20, and 26 and additionally rejecting claims 2-4, 6-8, 10-14, 16-19, 21, and 23-25 based, in part, on the findings of fact made by the Board in the Prior Decision as to the scope and content of Anderié.<sup>1</sup>

Appellant argues that the Examiner's rejection of claims 2-4, 7, 8, 10-14, 16-19, 21, and 23-25 is procedurally improper because the Examiner "was not entitled to make other grounds of rejection *on references already considered on appeal*." Br. 9 (citing Manual of Patent Examining Procedure (MPEP) § 1214.04). Appellant interprets the MPEP to require that:

in the face of the Board's complete reversal of the Examiner and issuance of a new ground of rejection, the Examiner may raise additional grounds of rejection only "if the examiner has specific knowledge of *a particular reference or references* which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed."

Br. 9-10 (quoting, in part, MPEP § 1214.04).

On appeal, the Board reviews adverse decisions of examiners. 35 U.S.C. § 6(b). In the Prior Decision, the Board reversed the Examiner's rejections based on the combined teachings of Anderié, Dubner, and Kraeuter because the Board found no reasonable basis in the collective teachings of the applied prior art for modifying the shoe of Anderié in the manner suggested by the Examiner with the teachings of Dubner and Kraeuter. Prior Decision 7-9. However, the Board also made new findings of fact as to how Anderié alone anticipated several of the claims on appeal. Prior Decision 9-11.

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<sup>1</sup> Claim 6 was subsequently canceled by Examiner's Amendment.

The Board's authority to enter a new ground of rejection under 37 C.F.R. § 41.50(b) is discretionary. The MPEP states that "[s]ince the exercise of authority under 37 C.F.R. § 41.50(b) is discretionary, no inference should be drawn from a failure to exercise that discretion." *See* MPEP, 8<sup>th</sup> ed., rev. July 2010, § 1213.02. The Examiner's rejection of additional pending claims, which relied on the Board's new findings of fact as to the scope and content of Anderié, were not improper under the MPEP. *See In re Borkowski*, 505 F.2d 713, 718 (CCPA 1974) (finding unpersuasive appellants' contention that a prior board decision reversing a rejection under 35 U.S.C. § 103 over a prior art reference to Borkowski in a parent application should have been "res judicata" to the examiner in the child case).

*Rejection of claims 1, 8-13, 15, 17, 20, 21, 24, and 26 under 35 U.S.C. § 102(b) as being anticipated by Anderié*

*Claims 1, 8-13, 15, 17, and 20*

Appellant argues the Examiner erred in rejecting claim 1 because Anderié does not teach or describe "a rib that projects beyond a bottom most surface of the torsion system" as called for in independent claim 1. Br. 7.

We find this limitation of claim 1 nonsensical. Claim 1 calls for a torsion system comprising a forefoot portion, a rearfoot portion, and an intermediate portion. The intermediate portion of the torsion system "includes a rib." Because the rib is part of the claimed torsion system rather than an element separate from the torsion system (*see* Ans. 4), we fail to see how it is possible that the rib projects beyond a bottom most surface of the

torsion system. For example, if the rib projects downwardly from the intermediate portion, then the bottom most surface of the rib is also the bottom most surface of the torsion system. Since the rib cannot project beyond its own bottom most surface, we find that those skilled in the art would not understand what is claimed when the claim is read in light of the specification. *See Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). As such, we enter a NEW GROUND OF REJECTION of claim 1 and its dependent claims 2-4 and 7-20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

A prior art rejection of a claim, which is so indefinite that “considerable speculation as to meaning of the terms employed and assumptions as to the scope of such claims” is needed, is likely imprudent. *In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (holding that the examiner and the board were wrong in relying on what were at best speculative assumptions as to the meaning of the claims and basing a rejection under 35 U.S.C. § 103 thereon.) As such, we reverse the rejection of claims 1, 8-13, 15, 17, and 20 under 35 U.S.C. § 102(b) as being anticipated by Anderié. Our reversal of this rejection is not based on a review of the merits of the rejection. Rather, this is a reversal of the rejection based on the indefiniteness of the claim language in the rejected claims.



*Claims 21 and 24*

Appellant argues claims 21 and 24 as a group. Br. 10-11. We select claim 21 as representative, and claim 24 stands or falls with claim 21. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant argues that the Examiner improperly issued a new rejection of claim 21 as anticipated by Anderié, because the Prior Decision recognized the “special characteristics” of a cycling shoe and rejected the Examiner’s position that any shoe used to pedal a bicycle can be a “cycling shoe” (*see* Prior Decision 8). Br. 10.

The question presented by Appellant’s argument is whether the preambular recitation of “a cycling shoe” limits claim 21.

“In general, a preamble limits the invention if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim. *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). “Conversely, a preamble is not limiting ‘where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.’” *Id.* (quoting *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997)).

The body of claim 21 recites a structurally complete invention such that deletion of the phrase “cycling shoe” would not affect the structure of the claimed invention. The body of claim 21 defines a torsion system comprising a sole plate. While the body of claim 21 refers back to the

forefoot and rearfoot areas of the sole as introduced in the preamble to describe the location of corresponding portions of the sole plate, the body of claim 21 does not depend on the “cycling shoe” phrase for antecedent basis. As such, we conclude that the preambular phrase “cycling shoe” describes the use of the invention, but does not otherwise limit claim 21.

“It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (citations omitted).

Appellant’s Specification describes a conventional cycling shoe as follows:

Conventional shoes manufactured for cycling typically include an upper, a rigid plate, and an optional rubber outsole. The rigid plate of the cycling shoe is typically made of nylon or composite materials. The rigid plate is provided to enhance pressure distribution between foot and pedal. Conventional cycling shoes are designed to be torsionally rigid for maximum pressure distribution over the pedal. Most cycling plates are rigid to the point of being substantially inflexible. Others incorporate a flexible toe region to facilitate better walking.

Spec. 1, ll. 10-15. In light of this description, any shoe including a rigid plate or portion that would enhance pressure distribution between foot and pedal is capable of being used for cycling, and thus would satisfy the preambular limitation of a “cycling shoe.”

Anderié discloses a sports shoe having an upper (not shown), a rigid plate (intermediate sole member 101 with stiffening element 109), and an outsole 102, where the stiffening element 109 stiffens the bottom of the shoe formed by intermediate sole 101 and outsole 102 so that the foot of the person wearing the shoe is firmly supported and guided in the rolling motion

of the foot and the stiffening element resists bending about bending axes B1 and B2. Anderié, fig. 10, col. 6, ll. 50-59. We see no reason why Anderié's sports shoe, including stiffening element 109, would not be capable of providing enhanced pressure distribution between the foot and the pedal such that it is capable of being used as a cycling shoe.

We acknowledge that the Prior Decision of this Board disagreed with the examiner's position that "any shoe can be used to pedal a bicycle" in light of the "recognized special characteristics of a 'cycling shoe'". Prior Decision 8. However, the prior panel's rejection of the Examiner's bald assertion that "any shoe can be used to pedal a bicycle" is not in conflict with our finding, above, that the particular shoe of Anderié is capable of such use. As such, we will sustain the Examiner's rejection of claim 21 under 35 U.S.C. § 102(b) as being anticipated by Anderié. Claim 24 falls with claim 21.

*Claim 26*

Appellant argues that the Examiner's rejection fails to set forth adequate findings as to how Anderié discloses a "rib [that] tunes torsionability of [a] cycling shoe" as called for in claim 26. Br. 8-9. Appellant's Specification describes that "[t]he rotation of the shoe, also known as torsional flex or torsionability, may be tuned by using I-beams or ribs with different torsional resistance." Spec. 3:12-13; *see also* Spec. 6, ll. 1-4 (describing that the rib "stiffens the shoe 1 against vertical flex without prohibiting rotation of the forefoot relative to the rearfoot" and that "[t]he torsional strength of the I-beam element or rib 20 along its

longitudinal axis may be used to tune the torsionability of the shoe 1 about the longitudinal axis 15.”). The Examiner found that Anderié discloses a “rib [that] tunes the torsionability of the article of footwear.” Ans. 5 (citing to Anderié, col. 5, ll. 62-66).

The cited portion of Anderié describes how the stiffening element 109 is produced by injection molding and can be stiffened in the limb portions 114 and 115 by glass or carbon fibers. Anderié, col. 5, ll. 62-66. The Examiner has failed to explain how this disclosure in Anderié anticipates a rib that tunes torsionability of a cycling shoe. There is no explicit disclosure in Anderié that these limb portions 114 and 115 are stiffened such that they are capable of tuning torsionability in a cycling shoe. Further, while Anderié discloses stiffened limb portions 114 and 115, it is not necessarily the case that the ribs are stiffened to a degree so as to inherently be capable of tuning torsionability in a cycling shoe. As such, the Examiner has failed to set forth an adequate prima facie case of anticipation of claim 26.

*Rejection of claims 23 and 25 under 35 U.S.C. § 103(a) as being unpatentable in view of Anderié and Nagano*

Claims 23 and 25 depend from claim 21. The Examiner relies on Anderié for the teachings as applied to claim 21, and relies on Nagano to teach that it is desirable to have a cycling shoe with a cleat attachment and an upper. Ans. 5-6. Appellant argues that the Examiner erred by combining the teachings of Nagano and Anderié because the Board determined that there was nothing in Nagano to cure the deficiencies of the combined teachings of Anderié, Dubner, and Kraeuter. Br. 11. We fail to see how the

Prior Decision's holding that there was no reasonable basis in the combined teachings of Anderié, Dubner, and Kraeuter for modifying Anderié's stiffening member 109 to span substantially the entire forefoot and rearfoot areas of the shoe sole and to have a generally smooth concave contour along the longitudinal axis, dictates a reversal of the Examiner's new rejection based on Anderié and Nagano. In particular, the rejection before us does not propose the same modifications to the stiffening member 109 of Anderié as were reviewed and rejected by the Prior Decision. As such, we will sustain the rejection of claims 23 and 25 under § 103.

*Rejection of claims 2-4, 7, 11-14, 16, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable in view of either Anderié or Anderié and Eisenbach*

Claims 2-4, 7, 11-14, 16, 18, and 19 depend either directly or indirectly from claim 1. As such, these claims suffer the same indefiniteness as claim 1 by virtue of their dependence therefrom. Hence, we reverse the rejections of claims 2-4, 7, 11-14, 16, 18, and 19 under 35 U.S.C. § 103 as a procedural matter based on the indefiniteness of these claims and not based on a review of the merits of the rejection. As stated *supra*, we enter a new ground of rejection against these claims under 35 U.S.C. § 112, second paragraph, for the same reasons discussed *supra* with respect to claim 1.

## CONCLUSIONS

We cannot determine whether Anderié discloses a rib that projects beyond a bottom most surface of the torsion system, as called for in claim 1, without resort to speculative assumptions as to the meaning of the claim.

The preamble recitation of “a cycling shoe”, as called for in claim 21, merely states an intended use of the claimed torsion system.

Anderié’s sports shoe is capable of use as a cycling shoe.

Anderié does not disclose a rib that tunes torsionability of a cycling shoe, as called for in claim 26.

### DECISION

The decision of the Examiner to reject claims 21 and 23-25 is affirmed. The decision of the Examiner to reject claim 26 is reversed.

The decision of the Examiner to reject claims 1-4 and 7-20 is reversed as a procedural matter, and we enter a NEW GROUND OF REJECTION of claims 1-4 and 7-20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter Appellant considers to be the invention.

### FINALITY OF DECISION

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides “Appellant may file a single request for rehearing within two months from the date of the original decision of the Board.”

In addition to affirming the Examiner’s rejection(s) of one or more claims, this decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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